

REMARKS

In view of the above amendments and following remarks, reconsideration of the rejections contained in the Office Action of November 30, 2007 is respectfully requested.

The following discussion will first deal with Applicants' prior amendment to recite that the tackiness between the first adhesive holding region and the main body, and the tackiness between the second adhesive holding region and the main body, are both larger than the first tackiness and the second tackiness. Further amendments to the claims and distinctions over the prior art will then be separately discussed.

Objections and Rejections Under 35 U.S.C. §112 and 132

The Examiner initially objected to the drawings as not illustrating the above-described relative tackiness of the adhesive holding regions.

It should first be noted that the amendment to the specification and claims introduced in the last response relates to the characteristic of the adhesive holding layer 12 of the pallet 1a as illustrated in Fig. 1 and Fig. 2. As will be discussed in detail below, it is clear from the specification and drawings that it is required that the adhesive holding layer 12, which is glued onto a planar base plate 11 (as described on page 6 of the original specification) more strongly adheres to the planar base plate 11 than to a circuit board that might be adhered to the surface. As such, this feature is a characteristic of the adhesive holding layer 12, for example, and with respect to claim 27, for example, a holding surface that includes the first and second adhesive holding regions.

The Examiner's attention is directed to Fig. 7. This figure illustrates that upon separation of the FPC 9, which had been held on the adhesive holding layer 12, the FPC 9 is peeled off and the adhesive holding layer 12 remains on the main body of the pallet 1a. Thus, the drawings do in fact illustrate this feature by showing how this happens.

Further, 37 CFR §1.83(a) requires that the drawing show every feature of the invention specified in the claims. However, by "feature" it is respectfully submitted that the rule refers to structural details of sufficient importance. The feature which the Examiner is requiring illustration of is not a structural detail, but a characteristic of the adhesive holding regions and their interaction

with a main body. As noted in MPEP §608.02(d), "any structural detail that is of sufficient importance to be described should be shown," citing *Ex Parte Good*, 164 OG 739 (Comm'r Pat. 1911).

It is respectfully submitted that the illustration of such a feature as the tackiness is not a feature that is ordinarily considered to be a structural detail that admits of illustration. Accordingly, withdrawal of the requirement is respectfully requested.

The Examiner next objected to the amendment as adding new matter, the Examiner citing the entire amendment to paragraph 31 of the specification. This amendment is that as discussed above, i.e. that the tackiness between the first and second adhesive holding regions and the planar base plate 11, serving as the main body, are larger than the tackiness of the first and second adhesive holding regions 21 and 22 with respect to the FPC 9. However, these statements added to the specification, as well as the amendments to the claims, are inherent in the specification as originally filed.

By disclosing in a patent application the performance of a function or a particular property, the patent application necessarily discloses that function or property even though the specification may say nothing explicit concerning such. The application may later be amended to recite the function or property without the introduction of new matter. See MPEP §2163.07(a), citing *In re Reynolds*, 170 USPQ 94 (CCPA 1971). That section of the MPEP goes on to discuss that in order to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present and that it would be so recognized by persons of ordinary skill in the art.

The tackiness between the first adhesive holding region and the main body and the tackiness between the second adhesive holding region and the main body are larger than the first tackiness and the second tackiness. In other words, the first and second adhesive holding regions require a smaller force to peel an object off of their regions than the force between such regions and the main body to which they are applied. The main body, it is noted, is formed by planar base plate 11 of pallet 1a, for example.

Support for this limitation is found in the original specification referring initially to paragraph 9 on page 6. This paragraph states that, as can be seen from Fig. 2, the pallet 1a has a structure such

that an adhesive holding layer 12 formed of an adhesive material is glued onto a planar base plate 11, which serves as a main body. As described in paragraph 10, a first adhesive holding region 21 has low tackiness and a second adhesive holding region 22 has a higher tackiness than the first adhesive holding region 21. Tackiness is the value corresponding to a force which is required to peel off an object which has adhered to the adhesive holding layer under certain conditions, and thus serves as a measure of adhesion.

As described in paragraph 12, the differences between the tackiness can be realized by varying the surface coarseness of the adhesive material. Reference is made to Table 1.

From the specification it is clear that the FPC 9 is mounted on and then peeled off of the adhesive holding regions, with the adhesive holding regions remaining on the main body. This inherently means that the tackiness between the main body and the adhesive holding regions is greater than the so-called first and second tackiness of such first and second regions for holding the circuit board.

In describing Fig. 4 and Fig. 5, the description of the operation proceeds in paragraph 30, beginning on page 15 of the original specification, to describe how after the FPC 9 is peeled off of the pallet 1a it is carried by the conveyor 61 to a cleaning apparatus 56 as shown in Fig. 5. That paragraph goes on to discuss that the clean-up mechanism 561 extends cloth containing a detergent, which abuts against the adhesive holding layer 12. Thus, the dust which is attached to the adhesive holding layer 12 is removed. Clearly, the adhesive holding layer 12 has remained (See also Fig. 7). The pallet is then moved to the conveyor 62, which is described as carrying the pallet 1a from the cleaning apparatus 56 to the loader apparatus 51. This is for reuse, because the loader apparatus initially loads the pallet into the mechanism. The pallet 1a is then moved on to the conveyor 61 by the pallet moving mechanism 514 of the loader apparatus 51.

Thus it is clear that the present specification removes the FPC 9, the adhesive region remains, the adhesive region is cleaned of dust, and the pallet is reused. Thus, to one of ordinary skill in the art it is inherently understood that the tackiness between the first and second adhesive holding regions and the main body is larger than the first tackiness and the second tackiness, because otherwise the adhesive holding region would not remain on the pallet, and the pallet could not be

recleaned and reused as described. Thus, the differential tackiness is an inherent characteristic that results from the description in the specification.

The Examiner's argument that the specification provides an alternative disclosure is incorrect. The Examiner refers to paragraphs 25-31 where it is stated that pins and blown air may assist the FPC to be peeled off the adhesive holding regions. However, these are not alternatives to the claimed relative tackiness. Simply because the FPC 9 is helped to be peeled off of the adhesive holding regions does not mean that the relative tackiness is not necessary. Even if FPC 9 is helped to be peeled off of the adhesive holding region 12, for example, as shown in Fig. 7, with pins and or with blown air, if the relative tackiness is not present, then the adhesive layer would follow the FPC 9, and not remain on the pallet. However, such remaining on the pallet of the adhesive is clearly indicated by the remainder of the discussion of the operation of the invention.

Accordingly, to add this characteristic to the specification and claims does not constitute new matter. Indication of such is respectfully requested.

Nor does such addition constitute violation of the written description requirement. It is clear from the original specification that Applicants' invention involves a reusable pallet having the adhesive holding region, with two different regions having differential tackiness. In order to be so-reusable, their tackiness with respect to the main body of the pallet must be greater than the tackiness of the first and second regions used during the process. Thus, this aspect is inherently part of the invention as originally contemplated by the inventors necessary for such reuse. Accordingly, the Examiner's objection based on failure to comply with the written description requirement is also respectfully submitted to clearly be incorrect, and is requested to withdrawn.

The Examiner's rejection of claims as being indefinite has been remedied by the above amendments.

Distinctions Over the Prior Art

No prior art rejection has been made of claims 27-30, 32, 38-40, 42 and 43. As such, as the remaining objections and rejections have either been overcome or should be withdrawn, these claims should stand in condition for allowance. Indication of such is respectfully requested.

Claim 44 is rejected as being unpatentable over Kuhns, U.S. Patent Publication 2004/0119593 and Sher, U.S. Patent 6,197,397.

It is noted that claim 44 has been amended to include part of the limitations of claim 39 amended above.

It is noted that the Examiner maintains the assertion that a "liner" as indicated in Kuhns, noting the third line of paragraph 41, corresponds to the main body of the claimed invention. According to Fig. 3a, this shows that the liner is completely peeled off when the sticker 20 is used. It is thus apparent that the tackiness between the adhesive 19 and the liner that is provided thereon has to be smaller than the tackiness between the adhesive 19 and the substrate 14. Thus, the claimed feature of the tackiness between the first and second adhesive holding regions and the main body is clearly not found in Kuhns.

Kuhns thus fails to disclose the limitations of the tackiness between the adhesive holding regions and the main body. The Examiner relies upon the patent to Sher for this limitation. However, even if combined with Sher, there is no disclosure or suggestion of a through hole for receiving a pin located in the first adhesive holding region so that the through hole is usable by the pin for peeling off the circuit board as recited in claim 44.

Further, the Examiner admits that the combination of Kuhns and Sher does not appear to explicitly disclose that the tackiness between the adhesive regions and the main body is larger than the first and second tackiness, but the Examiner still considers this obvious. However, the Examiner apparently considers this "obvious to try." The Examiner cites KSR International to support this proposition. However, as is made clear in KSR, the "obvious to try" standard is only appropriate in situations where there is a limited and finite number of options available to those of skill in the art. Further, in citing "common sense", what the Examiner is proposing is a modification that goes against the operation of Kuhns, and is not consistent with Kuhns. Rather, it seems to be clear that the Examiner is attempting a hindsight reconstruction of Applicants' invention with no real basis for the reconstruction.

The Examiner's further discussion of "well established legal precedent" to support a conclusion of an obvious matter of design choice is not well founded. A design choice is a legal

conclusion, and not a reason to make a modification. The Examiner states that the particular claimed tackiness limitations have not been disclosed as being for a particular unobvious purpose, etc. The point being made with the claim language however is that the nature of the invention is distinctly different from that of Kuhns, and the limitation points this out. Kuhns is a completely different type of device and operates in a very different way, and it is not obvious to modify it to work in accord with the present invention. Again, the Examiner's discussion is only supportive of the conclusion of hindsight reasoning, and not reasoning based upon evidence in the prior art. Nor does the present invention involve any optimization of range limitations.

Conclusion

No new matter has been presented by the prior amendments. These amendments clearly serve to define over the prior art cited by the Examiner. The Examiner's reconstruction of the present invention by the variously cited references, and the Examiner's highly strained interpretation of the case law to try to support this rejection, is clearly indicative of hindsight reasoning, which was held by the court in KSR as being impermissible. Withdrawal of the various rejections made by the Examiner, and allowance of the application as a whole, is accordingly requested.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact Applicants' undersigned representative.

Respectfully submitted,

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